

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

To:

see form PCT/ISA/220

WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY (PCT Rule 43bis.1)

Date of mailing
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference
see form PCT/ISA/220

FOR FURTHER ACTION
See paragraph 2 below

International application No.
PCT/EP2004/013720

International filing date (day/month/year)
02.12.2004

Priority date (day/month/year)
09.12.2003

International Patent Classification (IPC) or both national classification and IPC
B41M1/28, B05D3/14, H01T19/00

Applicant
METLAC S.P.A.

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA:



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International application No.
PCT/EP2004/013720

10/581163
MAY 2006

Box No. 1 Basis of the opinion

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
 - ☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material:
 - ☐ a sequence listing
 - ☐ table(s) related to the sequence listing
 - b. format of material:
 - ☐ in written format
 - ☐ in computer readable form
 - c. time of filing/furnishing:
 - ☐ contained in the international application as filed.
 - ☐ filed together with the international application in computer readable form.
 - ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	
	No: Claims	1-8
Inventive step (IS)	Yes: Claims	
	No: Claims	1-8
Industrial applicability (IA)	Yes: Claims	1-8
	No: Claims	

2. Citations and explanations

see separate sheet

AP20 Rec'd PCT/PTO 31 MAY 2006

Re Item V

**Reasoned statement with regard to novelty, inventive step or industrial applicability;
citations and explanations supporting such statement**

Reference is made to the following documents:

D1: US-A-4 051 044.

D2: US-A-3 451 871.

D3: GB-A-1 315 540.

1. The present application does not meet the requirements of Article 33(2) PCT, because the subject-matter of claims 1-8 is not novel with respect to prior art as defined in the Regulations (Rule 64 PCT). The reasons are as follows:

1.1 Document D1 discloses a method for the surface treatment of a metal substrate (see column 1, lines 1-7) consisting of applying an electrical discharge using an electrode, said electrical discharge having a voltage "above 5 kV" (preferably 10 to 15 kV, see column 2, lines 62-64, which overlaps with the range of 17 to 49 kV given in claim 1 of the present case) and a frequency of "about 20 kHz" (see column 3, lines 42-44, said value falling within the present claimed range of 18 to 24 kHz) on the surface of the metal substrate to be treated (conforming to claim 1).

Furthermore, document D1 describes a device (suitable) for the surface treatment of a metal substrate comprising an electrode made of a steel rod (denoted by number 1 on Figure 1) coated with a layer of insulating ceramic material (8) (see column 3, lines 5 to 7 in combination with Figure 1) (conforming to present independent claim 7).

In addition, the previously cited passages of document D1 describe the metal substrate produced by the process of claim 1 using the device of claim 7 (conforming to independent claim 8).

1.2 Document D1 also, either explicitly or implicitly, discloses the subject-matter of the dependent claims 2 to 6 which relate to further embodiments of the subject-matter of claim 1 (see the passages mentioned above).

1.3 Documents D2 and D3 similarly disclose the subject-matter of claims 7 and 8 of the present International Patent Application (see the passages cited in the International Search Report).

Therefore, the subject-matter of claims 1 to 8 is not novel according to Article 33(2) PCT with respect to prior art as defined in the Regulations (Rule 64 PCT).